REMARKS/ARGUMENTS

In response to the office action dated January 21, 2004, Applicants respectfully request reconsideration based on the above amendment and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1 and 4-25 were rejected in the office action. Claims 1 and 13 have been amended for clarification. No claims have been added or canceled. Therefore, upon entry of this amendment and response, claims 1 and 4-25 will remain pending in the application. No new matter has been added, and no additional prior art searches are required by the amendments.

In the official action, claims 1 and 4-25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Masri *et al.* (U.S. Patent No. 6,594,344) ("Masri") in view of Eidson (U.S. Patent No. 6,370,159). Applicants respectfully assert that amended claims 1 and 4-25 are distinguished over the teachings of Masri in view of Eidson for at least the reasons given below.

According to exemplary embodiments, a method is provided for testing a communication network using first and second clocks that each operate from substantially similar references. The method includes transmitting a first signal from a first point to a remotely located second point. A first clock time stamps the signal as it is transmitted from the first point, and a second clock time stamps the signal as it is received at the second point. Furthermore, a performance characteristic (*e.g.*, signal delay, signal distortion, signal

For example, claim 1 recites a method for testing a communication network. The method transmits a first signal from a first point to a second point of the communication network, where the first and the second points are remotely located. The method records at the first point a first time value of the transmitting using a first clock. A second signal is received at the second point of the communication network, and a recording is made at the second point a second time value of the receiving using a second clock. The first clock and the second clock each operate from substantially similar references. The method also compares the first signal and the second signal as a function of the first and second time values, and determines at least one performance characteristic of the communication network based on the comparing. Claim 1 has been amended merely to make explicit that which already was implicit in the claims; namely, that the each of the remotely located clocks operate from substantially similar references. Claim 13 has been amended in a similar manner to recite similar features.

The office action acknowledges applicants' previous contention that "Masri uses a single oscilloscope to test the telecommunication network and by using a single oscilloscope located at a single location, Masri cannot be said to operate in an environment where the recording of values used for testing is accomplished remotely." (*Office Action dated January 21, 2004* at p. 3). However, the office action contends that Eidson overcomes the limited teaching of Masri. Specifically, the office action suggests that Eidson's teaching of the use of an "apparatus for accurately ***distributing traceable time values*** to a set of nodes in a system" somehow teaches testing a communication network by recording a first time value at a first point using a first clock and recording a second time value at a second point using a second

clock, where the first and second points are remotely located. (*Office Action dated January 21, 2004* at p. 3) (emphasis added). With all due respect to the contentions in the office action, applicants respectfully disagree.

Quite simply, applicants argue that transmitting time values around a network in order to maintain synchronization (as taught by Eidson) cannot be said to teach testing a network, as recited in independent claims 1 and 13. Throughout its entire specification, Eidson expressly refers to "master clocks" and "slave clocks." Eidson teaches that time is synchronized by "a master clock . . . that ***distributes*** the master time value to the slave clocks via the communication link." (*Eidson* - Column 1, lines 32-37) (emphasis added). The synchronization protocol that is disclosed by Eidson and cited in the office action merely allows "the master clock 18 and the slave clocks 30-32 exchange packets via the communication link 12 so that the slave clocks 30-32 synchronize to the master time value held in the master clock 18." (*Eidson* – Column 2, lines 20-25). Therefore, Eidson's cited disclosure is directed to using a master clock to create a master time, and then transmitting the master time around to the other slave clocks. This is to be distinguished from presently amended claims 1 and 13, which describe the use of remotely located clocks that each operate from substantially similar references.

In addition, the Applicants respectfully assert that the office action has failed to provide sufficient evidence to establish a *prima facie* case of obviousness. *M.P.E.P. § 2143.01.* "The prior art must provide a motivation or reason for the worker in the art, without the benefit of [applicants'] specification, to make the necessary changes in the reference

device." M.P.E.P. § 2144.04 (*citing Ex parte Chicago Rawhide Manufacturing Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added). To establish a *prima facie* case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998).

In other words, the mere fact that references ***can be*** combined or modified does not render the resultant combination obvious unless the prior art also ***suggests the desirability*** of the combination. *M.P.E.P. § 2143.* The office action suggests that merely because the cited references can be modified, the combination of the references are obvious. The office action has not indicated where in the prior art a suggestion of desirability to modify and combine the references exists.

The office action states that it would have been obvious for any one of ordinary skill in the art to modify and combine Masri's "auto latency test tool" with Eidson's use of a synchronization protocol, so as to determine "latency between a signal originating at a telephony device and the signal as it arrives at another telephony device." (*Office Action dated January 21, 2004* at p. 5). The office action, however, fails to explain where or even if the quoted statements are suggested by the cited references. Therefore, should the Office choose to maintain this rejection, applicants respectfully request that the office action give an explicit citation as to where it is suggested, in either Masri and/or Eidson, that it would be desirable to modify and combine these references as the action has proposed.

Applicants assert that without support in any prior art for the desirability to combine Masri and Eidson, the office action's assertion of desirability amounts to nothing more than impermissible hindsight using the applicants' present invention. While assuming arguendo that impermissible hindsight reconstruction may lead to such a construction, 35 U.S.C. § 103 requires a higher standard in that a specific suggestion or motivation must be suggested in the prior art to modify the reference or to combine reference teachings. *See MPEP 2143.* For these reasons, Applicants respectfully submit that the 35 U.S.C. § 103 rejection should be withdrawn.

Accordingly, withdrawal of the rejection of claims 1 and 4-25 under 35 U.S.C. §103(a) as being unpatentable over Masri in view of Eidson is believed proper and respectfully solicited.

CONCLUSION

In view of the foregoing, applicants respectfully submit that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Vincent J. Roccia at (215) 564-8946, to discuss resolution of any remaining issues.

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